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October 15, 2007
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Our Case No. 8285/389

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Carol Gruchala

Serial No.: 09/652,540

Filing Date: August 31, 2000

For: METHOD, SYSTEM AND
ARTICLE FOR PROVIDING A
FAMILY TELECOMMUNICATION
SERVICE USING AN
ORIGINATING DUAL-TONE
MULTI-FREQUENCY TRIGGER

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) Examiner: Nguyen, Quynh H.
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) Group Art Unit No.: 2614
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)
)

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants submit this Replay Brief in response to the Examiner's Answer mailed
Aug. 27, 2007.

10/17/2007 WABDELRI 00000046 09652540

01 FC:1402 510.00 DA

10/17/2007 WABDELRI 00000046 231925
01 FC:1402 510.00 DA

I. Status of Claims

Claims 1-17 are pending, stand rejected, and are the subject of this appeal.

II. Grounds of Rejections to Be Reviewed on Appeal

1. Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,879,676 ("Contractor") in view of U.S. Pat. No. 5,953,401 ("Caveney").

VII. Argument

A. It Is Improper to Combine Contractor and Caveney

As explained in Applicant's Appeal Brief, because the portion of Contractor cited by the Examiner discloses providing a routing menu to a caller, which is the very action that Caveney is attempting to avoid, it is improper to combine Contractor and Caveney. The Examiner asserts that the fact Contractor and Caveney teach away from their combination is "totally irrelevant" because Caveney is only being cited for an originating dual-tone multi-frequency (DTMF) trigger in a telephone call. (See Examiner's Answer, page 6-7). Applicants respectfully disagree. MPEP § 2145 states "[i]t is improper to combine references when the references teach away from their combination." There is no mention of determining whether specific portions of a reference teach away from their combination and ignoring the remainder of the reference. Applicants maintain that because Caveney teaches away from a user receiving a generated voice message such as a menu, and the portion of Caveney cited by the Examiner discloses a user receiving a generated voice message such as a menu, it is improper to combine Contractor and Caveney as contemplated by the Examiner.

B. Rejection of the Independent Claims As Being Unpatentable Over Contractor in View of Caveney

Each of the independent claims recites providing a menu to a caller from a telephone network element in a telephone call, the menu providing a plurality of destination options including a first destination option for a residence of a family, a second destination option for a first member of the family at a first location other than the residence, and a third destination option for a second member of the family at a second location other than the residence. The Examiner has admitted that Caveney does not teach providing a menu to a caller. (See Office Action dated Dec. 1, 2005, page 6). The only reference cited by the Examiner that provides a menu to a caller is Contractor. However, Contractor fails to teach the above-recited element.

The Examiner asserts that a legal relationship between car dealers meets the elements of a family and family member. Applicants respectfully disagree. For example, the independent claims recite a first destination option for a residence of a family. One would not consider a location of a car dealership, or a location of a group

of car dealerships, to be a residence of a family. Interpreting a residence of a family to be a location of a car dealership or a location of a group of car dealerships conflicts with both the definition of a family as defined in the specification and the plain meaning of the word family.

Further, the Examiner asserts that “[a] list of destinations is a list of destinations.” (See Examiner’s Answer, page 8). Applicants respectfully disagree and submit that the Examiner is not giving proper weight to the actual language of the claims. Each of the independent claims recites specific destination options that are provided in a menu such as an option for a family residence and an option for a family member at a location other than the family residence. Properly interpreted, Contractor fails to teach these elements.

Because both Contractor and Caveney fail to disclose at least providing a menu to a caller from a telephone network element in a telephone call, the menu providing a plurality of destination options including a first destination option for a residence of a family, a second destination option for a first member of the family at a first location other than the residence, and a third destination option for a second member of the family at a second location other than the residence, and because it is improper to combine Contractor and Caveney, Applicants maintain that that the proposed combinations of Contractor and Caveney as contemplated by the Examiner necessarily does not render independent claims 1, 5, 9, or any claim that depends on claims 1, 5, and 9, unpatentable.

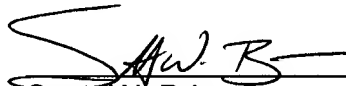
C. Rejection of Dependent Claims 4, 8, and 12 As Being Unpatentable Over Contractor In View of Caveney

In addition to the reasons set forth above with respect to independent claims 1, 5, and 9, dependent claims 4, 8, and 12 provide additional grounds for patentability. Dependent claims 4, 8, and 12 recite that at least a portion of a menu is provided in a telephone call after detecting an originating dual-tone multi-frequency trigger, or in response to detecting an originating dual-tone multi-frequency trigger. The Examiner has admitted that Caveney does not teach providing a menu to a caller. (See Office Action dated Dec. 1, 2005, page 6). The only reference cited by the Examiner that provides a menu to a caller is Contractor. However, the Examiner has also admitted

that Contractor fails teach detecting an originating dual-tone multi-frequency trigger in a telephone call. (See Office Action dated Nov. 14, 2006, page 3). Thus, both Contract and Caveney fail to teach providing a portion of a menu based on detecting an originating dual-tone multi-frequency trigger.

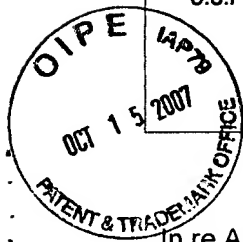
Because Contractor and Caveney fail to teach providing at least a portion of a menu in a telephone call after detecting an originating dual-tone multi-frequency trigger, or in response to detecting an originating dual-tone multi-frequency trigger, the proposed combination of Contractor and Caveney necessarily do not render dependent claims 4, 8, and 12 unpatentable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott W. Brim", is written over a horizontal line.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Carol Gruchala

Appln. No.: 09/652,540

Filed: August 31, 2000

For: Method, System and Article for Providing a
Family Telecommunication Service Using an
Originating Dual-Tone Multi-Frequency Trigger

Examiner: Nguyen, Quynh H.

Art Unit: 2614

Attorney Docket No: 8285-389

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Reply Brief (6 pgs)
☒ Return Receipt Postcard.

Fee calculation:

- ☐ No additional fee is required.
☐ Small Entity.
☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 CFR § 1.136(a).
☐ A petition or processing fee in an amount of \$_____ under 37 CFR § 1.17(____).
☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			X105=			x \$210=	
First Presentation of Multiple Dep. Claim					+\$185=			+ \$370=	
					Total	\$		Total	\$

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- ☐ A check in the amount of \$_____ is enclosed.
☒ Please charge Deposit Account No. 23-1925 in the amount of \$510.00. A copy of this Transmittal is enclosed for this purpose.
☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925. A copy of this Transmittal is enclosed for this purpose.

Respectfully submitted,

October 15, 2007
Date

Scott W. Brim (Reg. No. 51,500)

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